

REMARKS

Upon entry of the instant amendment, claims 1-11 will remain pending in the above identified application and stand ready for further action on the merits.

The amendments made herein to pending claims 1, 3 and 9 do not incorporate new matter in the application as originally filed, since the same find support in the originally filed application at page 4, lines 18-20 and 25-29; page 5, lines 1 and 5-7; and page 8, lines 21-23.

Accordingly, entry of the instant amendment is respectfully requested at present as is a favorable allowance of each of instantly pending claims 1-11.

Claim Rejections – 35 USC § 102(b) and 35 USC § 103(a)

Claims 1, 2-7 and 9-11 have been rejected under the provisions of 35 USC § 102(b) as being anticipated by **Nagai et al. US ‘859** (US 4,069,859).

Claims 3 and 8 have been rejected under the provisions of 35 USC § 103(a) as being anticipated by **Nagai et al. US ‘859** in view of **Brown et al. US ‘166** (US 4,981,166).

Reconsideration and withdraw of each of these two rejections is respectfully requested based on the following considerations.

Legal Standard for Determining Anticipation

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). “When

a claim covers several structures or compositions, either generically or as alternatives, the claim is deemed anticipated if any of the structures or compositions within the scope of the claim is known in the prior art.” *Brown v. 3M*, 265 F.3d 1349, 1351, 60 USPQ2d 1375, 1376 (Fed. Cir. 2001) “The identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Legal Standard for Determining Prima Facie Obviousness

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

“There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary

skill in the art.” *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) (The combination of the references taught every element of the claimed invention, however without a motivation to combine, a rejection based on a *prima facie* case of obvious was held improper.). The level of skill in the art cannot be relied upon to provide the suggestion to combine references. *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999).

“In determining the propriety of the Patent Office case for obviousness in the first instance, it is necessary to ascertain whether or not the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the reference before him to make the proposed substitution, combination, or other modification.” *In re Linter*, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. “The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art.” *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also *In re Lee*, 277 F.3d 1338, 1342-44, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002) (discussing the importance of relying on objective evidence and making specific factual findings with respect to

the motivation to combine references); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Distinctions Over the Cited Art

As indicated above, claim 1 as instantly amended herein recites as follows.

A part for casting comprising base paper for paper tubing and containing an organic fiber, an inorganic fiber, and a binder, the base paper being converted into a tube, the inorganic fiber being carbon fiber whose content is 1 to 40 parts by weight, and the total weight of the organic fiber, the carbon fiber, and the binder being taken as 100 parts weight. (emphasis added)

In the cited primary reference of Nagai et al. US '859, there is no disclosure or suggestion of any use of a carbon fiber in an amount of 1 to 40 parts by weight. As a result, it is submitted that the cited Nagai et al. US '859 reference is incapable of anticipating or rendering obvious instantly pending claim 1, or any of remaining pending claims 2-11 that ultimately depend from claim 1. This conclusion is based on the fact that the cited primary reference of Nagai et al. US '859 does not teach or provide for each of the limitations recited in pending claim 1 and provides no motivation that would allow one of ordinary skill in the art to arrive at the instant invention as claimed.

Additionally, concerning claim 9, the paper tube recited therein is a spiral-wound paper tube, whereas the paper tube of Nagai et al. US '859 is a flat-wound one. As a result, it is clear that the disclosure of Nagai et al. US '859 is incapable of anticipating or rendering obvious pending claim 9.

In the secondary cited reference of Brown US '166, too, there is no disclosure or suggestion of any use of a carbon fiber in an amount of 1 to 40 parts by weight. Therefore, the secondary cited reference of Brown US '166 does not cure the noted deficiencies in the primary cited reference of Nagai et al. US '859, and thus its combination with Nagai et al. US '859 is incapable of rendering obvious either of pending claims 3 or 8, or any of the remaining pending claims. Additionally, concerning independent claim 8, since the method for casting production recited therein uses the part for casting according to amended claim 1, it follows that claim 8 should also be patentable. Any contentions of the USPTO to the contrary are respectfully requested to be reconsidered at present.

CONCLUSION

Based on the amendments and remarks presented herein, the Examiner is respectfully requested to issue a notice of allowance clearly indicating that each of instantly pending claims 1-11 is allowed and patentable under title 35 of the United States Code.


Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact John W. Bailey (Reg. No. 32,881) at the telephone number below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.14; particularly, extension of time fees.

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Respectfully submitted,

JWB/jwb

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